

- Group I. Claims 1-6, and 8, drawn to nucleic acid;
- Group II. Claim 7, drawn to a transgenic animal;
- Group III. Claims 9-13 drawn to proteins;
- Group IV. Claim 14 drawn to antibody;
- Group V. Claim 15 drawn to method of drug discovery using protein;
- Group VI. Claim 16 drawn to a method of screening for compound using protein;
- Group VII. Claim 17 drawn to a method of identifying a compound, which modulates expression-using cell;
- Group VIII. Claim 18-19 drawn to a method of transferring nucleic acid in a cell; and
- Group IX. Claim 20 drawn to a method of treating disease by administering a compound that modulates the activity or expression of a protein.

The Examiner contends that the inventions of Group I-IX are distinct, each from the other.

In addition, the Examiner has imposed a further election of sequences for prosecution. In particular, if Group I, VII or IX is elected, then one of the following sequences: SEQ ID NO:1 or SEQ ID NO:3 must be elected for examination; if Group III is elected, then one of the following sequences: SEQ ID NO:2 or SEQ ID NO:4 must be elected for examination.

Applicants respectfully traverse the requirement for restriction. However, in order to be completely responsive to the outstanding Restriction Requirement, Applicants hereby provisionally elect with traverse to prosecute the invention of Group I, *i.e.*, claims 1-6, and 8, drawn to nucleic acid, and SEQ ID NO:1.

In the alternative, for reasons detailed below, Applicants respectfully request a modification of the restriction requirement so that within Group I, claims directed to SEQ ID NO:1 and to SEQ ID NO:3 are combined for examination together in a single application.

According to M.P.E.P. § 803, which states that:

if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (Seventh Edition, July 1998; emphasis added).

Applicants note that the inventions of Group I, SEQ ID NO:1 and SEQ ID NO:3 have been classified in the same class 536 and sub-class 23.1. Such classification evidences the recognized interrelationship of the inventions of SEQ ID NO:1 and SEQ ID NO:3.

Furthermore, the elected sequences are all related as variants of SGT4. In view of such co-classification, Applicants submit that to search the subject matter of the two sequences in the same group together would not be a serious burden to the Examiner. Therefore, the sequences of SEQ ID NO:1 and SEQ ID NO:3 in Group I should be searched and examined in the subject application.

Applicants further submit that the M.P.E.P § 803.04 (Seventh Edition, July 1998) states that:

[t]o further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. § 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

Here, less than ten nucleotide sequences (SEQ ID NO:1 and 3) need to be searched. The number of nucleotide sequences in claims 1-6, and 8 of the instant application is thus a reasonable number for a single application.

In view of the foregoing remarks, Applicants respectfully requests the Examiner to modify the restriction requirement so as to place claims 1-6, and 8 directed to SEQ ID NO:1 and to SEQ ID NO:3 within a single group.

Applicants reserve the right to petition from the restriction requirement under 37 C.F.R. § 1.144, and the right to prosecute the subject matters of non-elected SEQ ID numbers and non-elected claims 7, and 9-20 in one or more related applications.

### CONCLUSION

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. An early allowance of the application is earnestly requested.

Respectfully submitted,

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*Laura A. Coruzzi* by: *X. [Signature]* 40,258  
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Laura A. Coruzzi (Reg. No. 30,742)

PENNIE & EDMONDS  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090